

Applicant has failed to specifically apply each limitation or element of each of the copied claim(s) to the disclosure of the application.

Applicant is given ONE MONTH or THIRTY DAYS, whichever is longer, to specifically apply each limitation or element of each of the copied claim(s) to the disclosure of the application. THE PROVISIONS OF 37 CFR 1.136 DO NOT APPLY TO THE TIME SPECIFIED IN THIS ACTION.

**2307.01 Presentation of Claims
Corresponding to Patent
Claims Not a Reply to
Last Office Action**

The presentation of claims corresponding to claims of a patent when not suggested by the Office does not constitute a reply to the last Office action unless the last Office action relied solely on the patent for the rejection of all the claims rejected in that action.

**2307.02 Rejection of Claims
Corresponding to
Patent Claims**

When claims corresponding to claims of a patent are presented, the application is taken up at once and the examiner must determine whether the presented claims are unpatentable to the applicant on any ground(s), e.g., under 35 U.S.C. 102, 35 U.S.C. 103, 35 U.S.C. 112, 35 U.S.C. 135(b), double patenting, etc. If at least one of the presented claims is not rejectable on any such ground and is claiming the same invention as at least one claim of the patent, the examiner should proceed to propose an interference.

If all of the claims presented are rejectable on any grounds, they should be so rejected. The ground of rejection of the claims presented may or may not be one which would also be applicable to the corresponding claims in the patent. If the ground of rejection is also applicable to the corresponding claims in the patent, any letter including the rejection must have the approval of the TC Director. See MPEP § 1003.

Examples of grounds of rejection which would not also be applicable to the patent are double patenting, insufficient disclosure in the application, a reference whose date is junior to that of the patent, or a bar under 35 U.S.C. 135(b) (see MPEP § 2307).

The examiner should not proceed to propose an interference where the examiner is aware of a reference or other ground of unpatentability for the appli-

cation claims which correspond to the patent claims, even if the ground of unpatentability would also be applicable to the patent claims. Although an applicant may wish to have his or her application placed in interference with a patent in order to raise a ground of unpatentability against the patent claims, an interference will not be proposed unless at least one of the claims in the application corresponding to the claims of the patent is allowable.

If the patent has a filing date earlier than the application effective filing date, see MPEP § 2308.01.

37 CFR 1.607(b) requires that "[w]hen an applicant seeks an interference with a patent, examination of the application, including any appeal to the Board, shall be conducted with special dispatch within the Patent and Trademark Office." Therefore, when all the claims presented are rejected the examiner sets a time limit for reply, not less than 30 days, and all subsequent actions, including action of the Board on appeal, are special. Failure by the applicant to reply or appeal within the time limit, will, in the absence of a satisfactory showing, be deemed a disclaimer of the invention claimed.

While the time limit for an appeal from the final rejection of a claim corresponding to a patent claim is usually set under the provisions of 37 CFR 1.607(b), where the remainder of the application is ready for final action, it may be advisable to set a shortened statutory period for the entire application in accordance with 37 CFR 1.134.

There is an important distinction between a limited time for reply under 37 CFR 1.607(b) and a shortened statutory period under 37 CFR 1.134. The penalty resulting from failure to reply within the time limit under 37 CFR 1.607(b) is loss of the claim or claims involved, on the doctrine of disclaimer, and this is appealable; while failure to reply within the set statutory period (37 CFR 1.134) results in abandonment of the entire application. This is not appealable.

The rejection of claims presented for interference with a patent sometimes creates a situation where two different periods for reply are running against the application - one, the statutory period dating from the last full action on the application; the other, the limited period set for the reply to the rejection (either first or final) of the presented claims. This situation should be avoided where possible, for example, by setting a shortened period for the entire application, but where

the situation is unavoidable, it should be emphasized in the examiner's letter.

In this connection it is to be noted that a reply to a rejection or an appeal from the final rejection of the presented claims will not stay the running of the regular statutory period if there is an unanswered Office action in the application at the time of reply or appeal, nor does such reply or appeal relieve the examiner from the duty of acting on the application if it is up for action, when reached in its regular order.

Where an Office action sets a time limit for reply to or appeal from that action or a portion thereof, the examiner should note at the end of the letter the date when the time limit period ends and also the date when the statutory period ends. See MPEP § 710.04.

Form paragraph 23.13 may be used to reject a claim corresponding to a proposed count. Form paragraph 23.14 may be used to reject a claim as not being made prior to one year of the patent issue date. Form paragraph 23.14.01 may be used to reject a claim as not being made prior to one year from the application publication date. Form paragraph 23.15 may be used to notify applicant that the copied claims are drawn to a different invention.

¶ 23.13 Rejection of Claim Corresponding to Proposed Count

Claim [1] of this application has been copied by the applicant from U.S. Patent No. [2]. This claim is not patentable to the applicant because [3].

An interference cannot be initiated since a prerequisite for interference under 37 CFR 1.606 is that the claim be patentable to the applicant subject to a judgment in the interference.

Examiner Note:

This paragraph must be preceded by a rejection of the claim.

¶ 23.14 Claims Not Copied Within One Year of Patent Issue Date

Claim [1] rejected under 35 U.S.C. 135(b) as not being made prior to one year from the date on which U.S. Patent No. [2] was granted. See *In re McGrew*, 120 F.3d 1236, 1238, 43 USPQ2d 1632,1635 (Fed. Cir. 1997) where the Court held that the application of 35 U.S.C. 135(b) is not limited to *inter partes* interference proceedings, but may be used as a basis for *ex parte* rejections.

¶ 23.14.01 Claims Not Copied Within One Year of Application Publication Date

Claim [1] rejected under 35 U.S.C. 135(b) as not being made prior to one year from the date on which [2] was published under 35 U.S.C. 122(b). See *In re McGrew*, 120 F.3d 1236, 1238, 43 USPQ2d 1632,1635 (Fed. Cir. 1997) where the Court held that the

application of 35 U.S.C. 135(b) is not limited to *inter partes* interference proceedings, but may be used as a basis for *ex parte* rejections.

Examiner Note:

1. In bracket 2, insert the publication number of the published application.
2. This form paragraph should only be used if the application being examined was filed after the publication date of the published application.

¶ 23.15 Copied Claims Drawn to Different Invention

Claim [1] of this application is asserted by applicant to correspond to claim(s) of U.S. Patent No. [2].

The examiner does not consider this claim to be directed to the same invention as that of U.S. Patent No. [3] because [4]. Accordingly, an interference cannot be initiated based upon this claim.

2307.03 Presentation of Claims for Interference With a Patent, After Prosecution of Application is Closed

An amendment presenting a claim to provoke an interference in an application not in issue is usually admitted and promptly acted on. However, if the application had been closed to further prosecution as by final rejection or allowance of all the claims, or by appeal, such amendment is not entered as a matter of right.

An interference may result when an applicant presents claims to provoke an interference with a patent which provided the basis for final rejection. Where this occurs, if the rejection in question has been appealed, the Board of Patent Appeals and Interferences should be notified of the withdrawal of this rejection so that the appeal may be dismissed as to the involved claims.

Where the prosecution of the application is closed and the presented claims relate to an invention distinct from that claimed in the application, entry of the amendment may be denied. See *Ex parte Shohan*, 48 USPQ 326, 1941 C.D. 1 (Comm'r Pat. 1940). Admission of the amendment may very properly be denied in an application where prosecution is closed, if *prima facie*, the claims are not supported by the applicant's disclosure. An applicant may not present a claim corresponding to a patent claim which applicant has no right to make as a means to reopen or prolong the prosecution of his or her application. See MPEP § 714.19.